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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010-169	11/13/2001	Richard L. Scgar	169.12-0502	7782

164 7590 04/07/2004
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312 SOUTH THIRD STREET
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EXAMINER	
MILLER, BRIAN E	
ART UNIT	PAPER NUMBER

2652

DATE MAILED: 04/07/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,169

Applicant(s)

SEGAR ET AL.

Examiner

Brian E. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-16 and 18-22 is/are rejected.
- 7) ☒ Claim(s) 3 and 17 is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-22 are pending.

Election/Restrictions

1. Applicant's election with traverse of Group I, i.e., claims 1-5, 7-18, in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "the invention recited by claims 1-5 and 7-22 and the invention recited by claim 6 are not independent and distinct as required by 35 U.S.C. §121." This is not found persuasive because as set forth in the restriction requirement, the product as claimed can be made by another and materially different process such as one that does not require at least sputtering first and second seed layers. It is noted that the so called "method" of claim 4 does not recite any actual processing steps, as does claim 6. The terms used in claim 4, e.g., "providing", "forming", do not patentably distinguish from the product as recited in claim 15.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 6 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-5, 13-15, 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ainslie et al (US 4,761,699). (As per claims 1, 4 and 15) Ainslie et al discloses a slider assembly and bonding method, as shown in at least FIGs. 4-7, including: a slider 16 having a leading edge

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and trailing edge 26, the trailing edge having a forward face; a flex on suspension (FOS) bond pad 47; a slider bond pad 41; means for positioning the slider on the flex circuit material of the gimbal 40 such that the slider bond pad is aligned with the FOS bond pad which includes a notch (unnumbered) adjacent the forward face of the slider and an "extended" bond pad 41 which is aligned with the FOS bond pad (see col. 7, lines 13-15) wherein the means is considered to facilitate a "tolerance buffer." (As per claim 5) The slider is considered to be positioned on a suspension 40, which encompasses a gimbal (flexure) and a load beam, as is typically known in the art (see col. 2, lines 38-47); (as per claims 13-14 & 18-19) wherein there is a gap between the extended bond pad 41 and the FOS pad (see FIG. 7) and a ball bonding (82, 84) method is used to attach the slider to the flex circuit material.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 7-12, 16, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ainslie et al. For a description of Ainslie et al, see the rejection, supra. (As per claims 7-9 & 20-

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22) Ainslie et al remains silent as to the actual process of forming the notch, i.e., slicing with a grinding wheel; cutting using a laser, or etching with a wafer etch process, however, it is considered that as all of these methods were well known, any one of which would have been readily utilized by a skilled artisan to form the aforementioned notch in the slider. The motivation being that lacking any unobvious or unexpected results, the method for forming the notch (out of the three recited) would have been chosen through routine engineering experimentation, as they were all conventionally known.

Further, with respect to the dimensional parameters of the notch/bond pad (re claims 10-12), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided such dimensions in the course of routine engineering optimization/experimentation. Moreover, absent a showing of criticality, i.e., unobvious or unexpected results, the relationships set forth in claims 9-12 is considered to be within the level of ordinary skill in the art.

Additionally, the law is replete with cases in which the mere difference between the claimed invention and the prior art is some range, variable or other dimensional limitation within the claims, patentability cannot be found.

It furthermore has been held in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range(s); see *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Moreover, the instant disclosure does not set forth evidence ascribing unexpected results due to the claimed dimensions; see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir.

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1984), which held that the dimensional limitations failed to point out a feature which performed and operated any differently from the prior art.

With respect to claim 16, although pad 41 does not set forth a gold pad mounted thereto, at least from the disclosure of Ainslie et al (see col. 6, lines 32-36) which states that gold may be formed over pads 74, it would have also been obvious to have provided such over the extended pad 41.

The motivation would have been: gold is known to be a very good conductor and contain corrosion-resistant properties, as known by skilled artisans in this art.

Allowable Subject Matter

8. Claims 3, 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

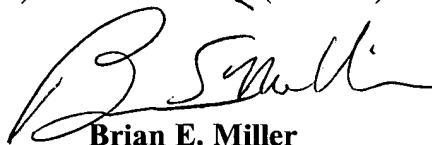
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (703) 308-2850. The examiner can normally be reached on M-TH 7:15am-4:45pm (and every other friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian E. Miller
Primary Examiner
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Bem
March 31, 2004